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GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			FORTUNA, JOSE A	
			ART UNIT	PAPER NUMBER
			1731	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 040104

Application Number: 09/646,119
Filing Date: October 30, 2000
Appellant(s): HALMSCHLAGER ET AL.

Neil F. Greenblum
For Appellant

EXAMINER'S ANSWER

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GROUP 1700

This is in response to the appeal brief filed on January 29, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 46-97 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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5,607,551	FARRINGTON, JR. et al.	3-1997
5,238,534	MANNING et al.	8-1993
3,378,435	LOYND	4-1968
GB 2 283 766	WENT et al.	5-1995

Smook, Gary A. "Handbook for Pulp & paper Technologist," second edition, pp 245-247.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 U.S.C. § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 46, 47 and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Turner et al., US Patent No. 4,830,709

Regarding Claims 46-47 and 74, Turner et al teach a device for making a multi-ply paper in which the different plies are made in separated headboxes, couched, and joined see figures. Turner et al. teach the making of cardboard and teach the advantage of joining the plies using the surface having fines on the surface, see column 2, lines 12-18. Also Turner et al. teach the use of a Multilayer headbox along with other types of headboxes in the multi-ply board, see figure 3 and column 6, lines 39-52 and teach in the same paragraph the formation of thin layer, i.e., a paper layer, and other layer being a

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board, paperboard, (for claims 46 and 76). Regarding claim 74, Turner et al shows in the figures the use of pressure elements in the outside of the felts/fabrics, see elements 22, 22a etc.

Claim Rejections - 35 U.S.C. § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Column.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. §103 and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

5. Claims 48-52 and 62-73, rejected under 35 U.S.C. §103(a) as being unpatentable over Turner et al., further evidenced by US patent Nos., 3,378,435, 5,607,551, 5,238,534 and GB 2 283 766.

Turner et al are silent with respect to the specific of these claims, i.e., the circulating of a dewatering belt over a former element, claims 48; including a headbox, claim 49; forming element being a roll, claims 50; two gap formers; claims 51; web traveling in different direction, claims 52. Regarding Claims 48-50 these claims define what is well known in the art, as a "Crescent Former," defined in US patent No., 3,3378,435 a more recently used in US Patent Nos. 5,607,551, 5,238,534, GB 2 283 766, DE 19704443 A1, etc. Note that the crescent former is a gap former, twin wire, see Smook below, having a forming element, a roll, in which a moving felt and a fabric wrap the roll, the felt run next to the roll and the fabric runs on the outside forcing the stock to drain through the fabric. Crescent formers are functionally equivalent to twin wires/gap formers and its use would have been obvious to one of ordinary skill in the art since he/she would have reasonable expectation of success if a crescent former is used instead of a functional equivalent twin wire. Note also that it has been held that "[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary." *In re Fout* 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); *In re Siebentritt*, 372 F.2d 566, 152 USPQ 618 (CCPA 1967).

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Regarding Claims 51 and 52, 71, Turner et al teach the use of two gap formers and shows in all the figures the formed web traveling in opposite directions before entering the couching zone. Claims 62-70, Turner et al. teach the use of several headboxes, including Fourdrinier formers and the different ways in which the layers having more fines can be joined. Turner et al teach the combination of gap formers and Fourdriniers, see figures and also teach that more than two plies can be made. Therefore, using more than one Fourdrinier or combinations of Fourdrinier and gap formers and the different manners in which the formers can and/or need to be placed in order to join the surfaces with more fines is with the levels of ordinary skill in the art in view of Turner et al teaching. Note that Turner et al teach the moving wire moving horizontally in the couching zone of claims 65 and 69, see figures. As to claim 72, Turner et al. teach only the use of single layer headbox; however the use of a multilayered headbox, which is a non-critical aspect of the invention, is within the levels of ordinary skill in the art since its use, i.e. the use of a multilayered headboxes, is conventional in the art, see cited references.

Response to Arguments

Applicant's arguments see Appeal Brief, filed January 29, 2004, with respect to the method claims have been fully considered and are persuasive. The rejection of those claims, claims 75-97, has been withdrawn.

Applicant's arguments filed on January 29, 2004, regarding the device claims, have been fully considered but they are not persuasive.

1) Turner et al. disclose gap formers. Note that as defined by the "Handbook for Pulp & Paper Technologist," by Gary A. Smook second edition, a gap former is a

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twin wire machine having blade in the surfaces of the wires, (Blade Former), or roll(s) for the dewatering of the web, (Roll Former). As Turner shows the use of twin wires, having blades on the surface of the wires, and combination of twin wire(s) of such wires and Fourdrinier machines, this limitation is met.

2) The Systems shown by the references have all the structural limitations as claimed since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Also, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). **Note that no structure and/or manipulative steps have been recited in the claims to obtain the fines distribution as claimed.**

Applicants state that Turner et al. do not teach the claimed apparatus, because they do not teach the joining the plies by the sides having the greater concentration of fines. Yet, they had not shown where is/are the structure that defines how those surfaces are joined. The device as claimed in the independent claim, just requires two formers with at least one of them being a gap former and a couching zone. This is shown by the

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cited reference see figures. The device shown by Turner et al. is inherently capable of being used as claimed, in view of the lack of structure in the joining of the plies with the higher fines content and/or what are the steps to obtain higher fines concentration on the surface to be joined.

The main issue is if the clause defining how the plies are joined, i.e., "a couching zone in which the at least two layers are couched together such that each layer's side having a higher content of fines contact each other" has sufficient to structure to define the device. The examiner contends that there isn't enough structure to define the device, since the clause defines the process of doing it, not how this is structurally done, and therefore, the device cited by the claimed reference reads on the claim.

Note that even though the claims are interpreted in view of the specification, the examiner cannot be imported from the specification to the claims.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


Jose A. Fortuna


Primary Examiner
Art Unit 1731

JAF

April 2, 2004

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